

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences**

In re Patent Application of

GING et al.

Atty. Ref.: JPD-4398-286

Serial No. 10/781,949

TC/A.U.: 3772

Filed: February 20, 2004

Examiner: Nihir B.Patel

For: NASAL MASK ASSEMBLY

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March 13, 2009

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

In response to the Examiner's Answer dated March 2, 2009, consideration of the following remarks is respectfully requested.

On page 8, paragraph number 10, of the Examiner's Answer, in response to Appellants' arguments that Palkon et al. does not disclose or suggest any values for the width of the membrane orifice, the width of the rim orifice, the membrane heights in each of the three regions, including the lip region, the nasal bridge region, and the side regions and/or the rim heights in each of the three regions, the examiner responds, "the examiner disagrees with Appellant's arguments. The dimension values of the membrane orifice, rim orifice, membrane heights in each of the three regions, lip region, nasal bridge region, side regions in each of the three regions as described in claim 8 will depend on the size of

the particular patient; the patient may be babies, kids or adults. Not all babies, kids or adults have the same size requirements and they will differ between one another. Since the size of the device depends on the size of the patient (i.e. babies, kids or adults) this is considered to be an obvious matter of design choice.”

Appellants respectfully resubmit that Palkon et al. does not disclose or suggest any values for the features recited in claim 8, and claims 9-12 and 22, and the Examiner’s Answer confirms this. The examiner cannot cite to any portion of Palkon et al. in which a value for any of the features recited in claims 8-12 and 22 can be found.

With respect to claims 20 and 21, the examiner alleges on page 9, lines 17-21, that Palkon et al. disclose various dimensions. However, the examiner does not point to any portion of Palkon et al. that discloses the claimed dimensions. It is respectfully submitted that the examiner does not point to any portion of Palkon et al. because Palkon et al. do not disclose what the examiner alleges.

Appellants also respectfully note that the examiner provides no response to Appellants’ arguments that the facts of In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955), are not sufficiently related to the facts of the instant application to permit the examiner to rely on the rationale used by the court.

Appellants also respectfully note that the examiner does not provide any response to Appellants’ arguments that Palkon et al. fails to recognize any of the features recited in claims 8-12 as result effective variables, as is required by the rationale used by the court in the case of In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

With respect to the examiner's new conclusion that the size of the features recited in claims 8-12 would have been "an obvious matter of design choice," Appellants respectfully note that the examiner has not provided any response to Appellants' arguments that the "design" of the nasal masks recited in claims 8-12 and 20-24 include features not disclosed or suggested by any of the prior art. See, for example, the arguments presented on page 19, lines 10-21, of the Appeal Brief.

Finally, with respect to the examiner's determination that the features recited in claims 8-12 and 20-24 would have been an obvious matter of design choice, Appellants respectfully submit that the examiner has not considered Appellants' arguments as part of the totality of the record. See, for example, In re Chu, 66 F.3d 292, 298-299, 36 USPQ 2d 1089, 1094-95 (Fed. Cir. 1995).

Reversal of the rejections and passage of the above-identified application to issuance are respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /John P. Darling/
 John P. Darling
 Reg. No. 44,482

JPD:tlm
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100